

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Anjali CHANDNANI et al.

Serial No.: 09/905,343

Confirmation No.: 3770

Filing Date: July 14, 2001

Group Art Unit: 2137

Examiner: Kevin R. Schubert

Title: **DETECTION OF POLYMORPHIC SCRIPT LANGUAGE
VIRUSES BY DATA DRIVEN LEXICAL ANALYSIS**

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants respectfully contend that the rejection of Claims 1-26 contains clear legal and factual deficiencies, as described below. Applicants request a finding that these rejections are improper and allowance of these claims.

Section 112 Rejections

The Final Office Action mailed June 6, 2006, (the "Final Office Action") rejects Claims 24-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Final Office Action contends that the limitation "comparing the at least one software operation with a repository of virus detection data" of Claim 24 is not described in the Specification. (Final Office Action, page 2.) Applicants respectfully traverse these rejections for the reasons stated below.

The question raised under 35 U.S.C. § 112, first paragraph, is whether a patent specification describes the claimed invention such that one of ordinary skill in the art can recognize a description of the invention defined by the claims. *See MPEP § 2163.I.* For at least the reasons described in Applicants' Response dated August 7, 2006 at pages 9-10¹, Applicants respectfully submit that one of ordinary skill in the art would recognize a description of "comparing the at least one software operation with a repository of virus detection data," as recited in Claim 24.

The Advisory Action mailed August 15, 2006, (the "Advisory Action") asserts that Claim 24 is not literally described in a particular passage in the Specification. *See Advisory Action, page 2.* However, even assuming for the sake of argument that the cited passage of the Specification does not literally describe *in haec verba* Claim 24 (which Applicants do not concede), such a description has never been required under the statute. *See In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989). According to the MPEP, "[t]he subject matter of the claim need not be described literally in order for the disclosure to satisfy the description requirement." *See MPEP § 2163.02.* Further, a determination of whether the written description requirement is satisfied must be based on the disclosure a whole. *See MPEP § 2163.III.*

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

Incredibly, on one hand, the Advisory Action contends that a two-sentence description of *Fermoyle* anticipates Claim 24 (i.e., shows the identical invention in as complete detail as in Claim 24). On the other hand, the Advisory Action contends that a person of ordinary skill in the art would not recognize that Applicants' disclosure pertains to operations that may be performed in software or that searching for a pattern is a software operation. See *Advisory Action*, page 2, third paragraph. The specification of the present invention specifically indicates that a "potentially infected file... may be downloaded to a computer through [a] network" (See *Specification*, page 7, lines 10-13) and yet the Examiner seems unsure whether or not this encompasses software.

For at least these reasons, Applicants respectfully request that the rejection of Claims 24-26 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Section 102 Rejections

The Final Office Action rejects Claims 1, 4-9, 13-16, and 19-26 under 35 U.S.C. § 102(a) as allegedly being anticipated by *Firm Offers Free Tool to Fight "Love You" Virus* by Ken Fermoyle ("*Fermoyle*"). Applicants respectfully traverse these rejections for the reasons stated below.

As the PTO is aware, in order for a reference to anticipate a claim "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (Emphasis Added). With this threshold requirement in mind, Applicants respectfully submit that the PTO has failed to establish a *prima facie* case of anticipation using *Fermoyle*.

Applicants have consistently argued during prosecution that *Fermoyle* does not disclose, teach or suggest "preparing language description data corresponding to at least one script language" or "preparing detection data for viral code corresponding to the script language virus" of Claim 1. See, e.g., *Applicants' Response* dated August 7, 2006 at pages 10-11. Briefly stated, Applicants respectfully submit that Claim 1 is allowable at least because *Fermoyle* fails to disclose the identical invention in as complete detail as Claim 1.

In each office action to date, the Examiner has failed to indicate: (i) which language description data is allegedly prepared in *Fermoyle*; (ii) which script language the language data allegedly corresponds to; (iii) which detection data for viral code is allegedly prepared in *Fermoyle*; and (iv) which script language virus the detection data for viral code allegedly

corresponds to. Without knowing how the Examiner is interpreting the two sentence description of *Fermoyle*, Applicants are unable to prove the negative (e.g., that the limitations above are not disclosed, taught or suggested by *Fermoyle*).

Nevertheless, the Advisory Action asserts that Applicants' previous arguments fail to comply with 37 C.F.R. 1.111(b). *See Advisory Action, Page 2*. This assertion is respectfully traversed, because it is sufficient for Applicants to identify claim limitations that are entirely absent from *Fermoyle*. Again, as a practical matter, Applicants are being asked to "prove a negative" with respect to limitations missing from *Fermoyle*. For at least these reasons, Claim 1 is allowable, as are all claims depending therefrom. Claims 13-16 are patentably distinguishable from *Fermoyle* for analogous reasons, as are all claims depending therefrom.

Claim 24 is directed to a method that includes receiving a data stream and lexically analyzing the data stream to identify at least one software operation associated with the data stream. The software operation is compared with a repository of virus detection data. *Fermoyle* does not disclose each of these limitations. For example, there is no suggestion that *Fermoyle* has the ability to identify a software operation associated with the data stream. For at least these reasons, Applicants respectfully submit that Claim 24 is patentably distinguishable from *Fermoyle*, as are Claims 25 and 26, which depend therefrom.

Section 103 Rejections

The Final Office Action rejects Claims 2-3 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over *Fermoyle* in view of Session 19: Intro to Compiler Design: BNF, Recursion and Finite Automata, Fall 1999, Computer Science Courses CS373 ("*Session*"). Applicants respectfully traverse these rejections for the reasons stated below.

Each of these rejections is based upon a mischaracterization of *Fermoyle*. As discussed above, *Fermoyle* does not disclose, teach or suggest the identical invention in as complete detail as Claim 1 and Claim 16. Claims 2-3 each depend from Claim 1, and Claims 17-18 each depend from Claim 16. For at least these reasons, Applicants respectfully submit that Claims 2-3 and 17-18 are each patentably distinguishable from the references of record.

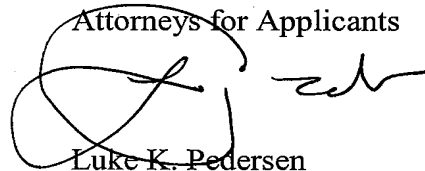
CONCLUSION

As the rejection of Claims 1-26 contains clear deficiencies, Applicants respectfully request a finding of allowance of all claims in the Application.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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Date: September 6, 2006

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